

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. FLATHAU, ALAN E. SOLTYSIK and ROBERT A. SPINDLER

Appeal No. 2000-0516
Application No. 08/935,609

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and JENNIFER D. BAHR,
Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 32. Claims 29-31 stand allowed. The preliminary amendment (Paper No. 3) filed September 23, 1997 included on page 1 thereof an express request to cancel claims 25-28 and add claims 29-32, but indicated on page 3 thereof that claims 1-28 were canceled in that amendment. The examiner (Paper No. 5, page 2) interpreted the above-mentioned preliminary amendment as canceling

claims 1-28¹ and treated claims 29-32 as pending. The appellants' intent to cancel claims 1-28 was confirmed in the remarks on page 2 of the amendment filed February 8, 1999 (Paper No. 9). In any event, it is clear from the appellants' brief (Paper No. 14, page 1) and the examiner's final rejection (Paper No. 10, page 1) that both the appellants and the examiner consider claims 29-32 to be the only claims pending in this application and that claim 32 is the only claim before us on appeal.²

BACKGROUND

The appellants' invention relates to a method of retrofitting a support member to a preexisting concrete form. The support member may be used to facilitate attachment of safety hooks or other fall-prevention devices or as a handle for carrying the concrete form (specification, page 7). Further understanding of the invention can be derived from a reading of method claim 32, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

McMullan

2,574,274

Nov. 6, 1951

The following rejection is before us for review.

Claim 32 stands rejected under 35 U.S.C. § 103 as being unpatentable over McMullan.

¹ The reference to claims 1-31 as having been canceled in the preliminary amendment was apparently an error on the part of the examiner.

² A review of the application file reveals that claims 1-24 have not been clerically canceled. We leave this informality to be resolved by the examiner in the event of further prosecution.

Reference is made to the brief (Paper No. 14) and the answer (Paper No. 15) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and method claim 32, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

McMullan discloses a system of shuttering for the construction of concrete walls. In particular, McMullan's shuttering system utilizes a plurality of shutters (forms) each comprising a metal panel 15 (the concrete-forming member) and a frame including a plurality of horizontal L-shaped stiffeners 16 and end vertical members 18 welded to one another and to the panel. Additionally, a central vertical stiffener 17 of channel section is also welded to the top and bottom members (horizontal stiffeners) of the frame and to the panel where the span of the shutter requires it (column 3, lines 41-68). Such shutters are illustrated in Figures 8-12, for example. Figure 35 illustrates a shuttering system which appears to employ lower shutters comprising a pair of vertical stiffeners, each offset from the vertically extending centerline of the shutter and connected between two adjacent horizontal stiffeners.

The examiner (answer, page 3) contends that to have provided any number of reinforcing struts 17 extending between any two inner frame members, thus affording any

desired degree of stiffness to the form panel, as well as placing the support struts at any specific time during manufacturing, including after the inner and outer frame members have been assembled to the flat concrete forming member (panel 15), would have constituted an obvious expedient to one of ordinary skill in the art and the appellants do not challenge this contention (see brief, page 4, line 1).

The sole issue in dispute in this appeal is whether the placement and welding of the vertical stiffeners 17 to the shutter after the end vertical members 18 and horizontal stiffeners 16 have already been welded to one another and the panel 15 meets the method claim limitation "**retrofitting** said support member to said preexisting concrete form . . ." (emphasis ours). The examiner takes the position that a procedure of attaching the support member (vertical stiffener) to a frame after the frame has been assembled, thus constituting a pre-existing form as recited in the claim, meets this limitation (answer, page 4). The appellants cite the following dictionary definition of "retrofit":

to furnish (as a computer, airplane, or building) with new parts or equipment not available at the time of manufacture [Webster's Ninth New Collegiate Dictionary (Merriam-Webster 1990)]

and urge that, even if the vertical stiffener were attached to the frame in a final step of manufacture, this would not constitute "retrofitting . . ." as claimed (brief, page 4). We agree with the appellants.

The term "retrofit" as customarily used refers to a procedure wherein updated components or parts are provided, either as replacement parts or additional features, on a

finished product (i.e., one recognized as having utility in its present form, without modification) after the time of manufacture of such product. The securement of a component to an intermediate product as part of the process of manufacturing a finished product is not "retrofitting" as one of ordinary skill in the art would understand that term. Having reviewed the disclosure of McMullan, we have not found any, and the examiner has not pointed to any, teaching or suggestion therein that the shutter disclosed therein is considered a finished product, having utility as a shutter (form), without all necessary vertical stiffeners welded thereto. Therefore, we conclude that the step of welding a vertical stiffener to the frame and panel, even if performed after the end vertical members and horizontal stiffeners have already been welded to each other and to the panel, is not a step of "**retrofitting** said support member to said preexisting concrete form" as required by the claim.

We also hasten to point out that, while the concept of retrofitting components to finished products after the time of manufacture, at a site of use, for example, is well known generally, the examiner has neither alleged nor offered evidence that it was conventional in the art of concrete wall forming to retrofit vertical stiffeners to finished shutters or forms (see brief, page 5, last paragraph).

Accordingly, we shall not sustain the examiner's rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claim 32 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH
Senior Administrative Patent Judge

IRWIN CHARLES COHEN
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Martin J. Hirsch
MARSHALL, O'TOOLE, GERSTEIN,
MURRAY & BORUN
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402